

Application No. 09/887,609
Amendment "D" dated October 12, 2005
Reply to Office Action mailed July 27, 2005

REMARKS

The Office Action, mailed July 27, 2005, considered and rejected claims 1-7 and 9-45. Claims 1-7 and 9-45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Knee et al. (U.S. Patent No. 5,589,982) in view of Prochl et al. (U.S. Patent No. 6,690,391).¹

By this paper, claims 1, 18 and 23 have been amended and new claim 46 has been added, such that claims 1-7 and 9-46 now remain pending.² Claims 1, 18, 23 and 27 are the only independent claims at issue.

The present invention is directed to a various embodiments that include a menu system that displays categories and subcategories in a unique ratcheting interface. For example, as claimed, the menu system provides various categories that, when selected, are each displayed at a selected location on the screen. All of the subcategories corresponding to a selected category are also displayed in a horizontal line with each selected category.

In the last action, the Examiner found that claims of this scope were obvious in view of Knee and Prochl. Applicants respectfully disagree, inasmuch as neither reference suggests or discloses, among other things, a menu system in which all of the subcategories corresponding to all of the various displayed categories are only ever displayed in a substantially similar horizontal placement on the display screen. Applicants also submit that it would be improper to combine these references to reach the asserted combination of teachings.

In the last action, the Examiner cited Knee for the general proposition of displaying categories on a display and in response to the selection of a category, displaying the corresponding subcategories corresponding to the category in a horizontal line such that only horizontal scrolling is necessary to access the corresponding subcategories, without any vertical scrolling. The Examiner also cited Knee for the general proposition that the only subcategories displayed at one time are the subcategories corresponding to the selected category. The

¹ Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

² The amendments are clearly supported by the Figures, (see Figures 4A-7A), as well as the corresponding description in the specification. Support for the new claim 46 is provided by Fig. 5D and page 21, ll. 21-23.

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Examiner then acknowledged that Knee fails to teach the claimed element that a second selected category replaces a first category in a selected position of a display screen. This is one of the unique features of the present invention, thereby allowing the categories to be ratcheted, as discussed thoroughly throughout the specification, so as to minimize the amount of display that is hidden by the menu system. In particular, "as a user selects categories of the menu system, the system ratchets up or down on the display screen so as to always minimize the amount of programming or web page that is blocked on the display screen by the menu system." (page 5, ll. 12-23)

With regard to such ratcheting, which is clearly not taught or suggested by Knee, the Examiner has relied on Proehl. However, while Proehl does show ratcheting, Proehl's ratcheting appears to be different than Applicants ratcheting. In particular, Applicants ratcheting is performed to minimize the amount of the display that is obstructed during navigation of the menu and is performed in such a way that the subcategories for the various selectable categories are all displayed in a substantially similar horizontal alignment, regardless of which category is selected. In contrast to this characteristic of Applicants invention, Proehl actually teaches that the subcategories of the various categories are ultimately displayed and navigated through vertical listings that are displayed when a category or subcategory is selected. Although Proehl's definitions of categories and subcategories are somewhat loose³, it is clear that virtually every displayed item or field (which inherently includes subcategories by Proehl's definition) is a vertically navigable field of a plurality of fields. Accordingly, Proehl essentially provides a system wherein the subcategories corresponding to a particular category are displayed and navigated in a vertical direction.⁴ In fact, even the passage cited by the Examiner (Col. 8, ll. 44-51) relates to the vertical navigation of subcategories (CD tracks) corresponding to a particular category (CD). Various other Figures and descriptions in Proehl also clarify that the various subcategories/categories displayed are vertically navigable fields, such that when the field is selected or highlighted, that a plurality of different options are displayed in a vertical line. (See for example, Figures 7-15).

Accordingly, while Proehl does disclose one type of ratcheting, it is applied differently, to some degree, in Proehl than in the present claims. At the very least, Proehl fails to disclose or

³ Col. 7, ll. 32-42.

⁴ Col. 8, ll. 19-21; Col. 9, ll. 1-5, 16-19, as well as many portions.

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suggest that every selected category is moved to the same position or location on the display screen, as claimed, particularly when considering that every subcategory of Proehl is also defined by Proehl to also be a category⁵. In particular, every selected category in Proehl does not end up being displayed at the exact same location on the display screen, as claimed.

Accordingly, Proehl also clearly fails to teach or suggest that every subcategory corresponding to each of the displayed categories is displayed with the same horizontal alignment, regardless of which category is selected, as further clarified by the claim amendments. Instead, when a field is selected it causes a vertical list of the various corresponding subcategories to be displayed, which is contrary to the language recited in the claimed invention.

Knee also fails to disclose the foregoing features. Instead, Knee's menu system (Fig. 6) includes various icons (61A, 62A, 63A, 64A) that are displayed with either (1) related icons (65A-C) or (2) a corresponding textual description of the corresponding contents, along their own respective horizontal lines. (Figure 6, Col. 17, ll. 55-62). When one of the icons is selected the textual description is then replaced by the plurality related icons or windows. (Col. 17, ll. 55-62).

In this regard, it would not make sense to combine the teachings of Poehl with Knee, even if their combined teachings did make obvious the claimed invention, which Applicants submit they don't, for at least the foregoing reasons. Knee appears to teach away from ratcheting inasmuch as ratcheting could ultimately reduce the visibility of the textual descriptions that are displayed at any given time, particularly if they were to be ratcheted off of the screen, which would apparently be undesirable for Knee, inasmuch as Knee has explicitly recited that the textual descriptions are to be displayed in the first place, and presumably to be displayed.

Nevertheless, even if the teachings of Knee and Poehl are combined, Applicants respectfully submit that the combined teachings of these references still fail to disclose or suggest a menu system or method in which (1) all of the displayed categories, when selected, are ratcheted to the same location on the display and (2) that all of the subcategories, when displayed, are also correspondingly ratcheted to and displayed along a single horizontal line on the screen, as claimed, particularly in combination with the other recited claim elements.

⁵ Col. 7, ll. 32-42.

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Although some of the elements of the claimed invention might be present in the cited art and although with significant and undue modification it might be possible to implement some of the claimed embodiments, Applicants respectfully remind the Examiner that simply because something is possible, does not make it obvious. In particular, in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all claim limitations." MPEP § 2143. The "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP 2143.01 (original emphasis). Furthermore, Applicants also point out that the motivation for making such a combination must come from the art itself; otherwise, such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure."⁶

Accordingly, for at least these reasons, Applicants respectfully submit that the cited art fails to anticipate or make obvious Applicants' invention, as claimed, for example, in the independent claims. In view of this, Applicants note for the record that the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually. However, in this regard, it should be appreciated that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions at any appropriate time in the future, should it arise, including any official notice⁷.

⁶ MPEP 2143. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

⁷ Applicants respectfully traverse all of the official notice cited in the last action and request that the Examiner provide art supporting the assertions of official notice inasmuch as the assertions were made in regards to what "is well known in the art", rather than what "was" well known in the art at the time of the invention. (with specific regard to claims 36, 43, 45).

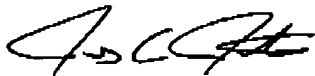
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Although it is not necessary to address the dependent claims, Applicants respectfully point out that new claim 46 also further distinguishes the present invention from the art of record inasmuch as the cited art fails to disclose or suggest any method wherein selection of a subcategory corresponding to television programming causes the user interface to display a menu that only corresponds to a single channel and that includes a title of a currently aired program and a title of a program that is scheduled to be aired next on the single channel, and without displaying additional titles or information corresponding to other channels.

In view of the forgoing, Applicants respectfully submit that the pending claims are now in condition for prompt allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 12 day of October, 2005.

Respectfully submitted,



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